

Appl. No.: 10/031,690
Group Art Unit: 1714
Applicants' Response to the Office Action dated October 8, 2004

REMARKS

Claims 14-33 are currently pending in the present application.

In the Office Action, the Examiner rejects claims 14-27 under 35 U.S.C. §103(a), as being unpatentable over U.S. Pat. Pub. No. US20030093941 of Wenzel, now U.S. pat. No. 6,348,074 (hereinafter referred to as "Wenzel"). The Examiner also rejects claims 28-32 Under 35 U.S.C. §103(a), as being unpatentable over Wenzel further in view of U.S. Pat. No. 4,297,107 of Boehmke (herein after referred to as "Boehmke"). However, the Examiner has not rejected claim 33. Claim 33 is not addressed in the Detailed Action, nor is it listed anywhere on the Form PTOL-326 attached to the Office Action. Applicants have assumed for the purposes of this response that claim 33, directed to a method of emulsifying a fuel and water, is allowable. If this is not the case, Applicants request that the Examiner address claim 33 on the merits in the next communication, and that any such communication containing a rejection of claim 33 be made non-final.

Applicants traverse the Examiner's rejections, and the arguments and contentions set forth in support thereof for the following reasons.

As to the rejection of claims 14-27, the Examiner contends that Wenzel discloses a fuel additive composition containing, "... one or more of b) one or more straight or branched chain alcohols having between 6-18 carbon atoms and c) one or more ethoxylated alcohols having between 12 and 18 carbon atoms where the ethylene-oxide add-on is less than 5 moles and ..." (See, the Office Action, p. 2, ¶ 3). The Examiner acknowledges that Wenzel fails to specifically teach a composition comprising a fuel, water and an emulsifier comprising a mixture of (i) a branched-chain fatty alcohol having from 12 to 24 carbon atoms, and (ii) an ethoxylated fatty alcohol having from 8 to 24 carbon atoms and from 1 to 10 moles of ethylene oxide per mole of alcohol. However, the Examiner argues that because Wenzel discloses the use of a straight chain C₁₈ alcohol in the examples, that the use of a branched chain C₁₂₋₂₄ alcohol is clearly suggested.

Applicants respectfully disagree and submit that Wenzel does not render the claimed invention *prima facie* obvious. Wenzel discloses a variety of fuel additive compositions

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which may optionally include one or more alcohols in addition to the short-chain water-soluble alcohols required by the reference. One alternate embodiment disclosed in Wenzel references a fuel additive composition containing one or more straight or branched chain alcohols having from 6-18 carbon atoms, more preferably 6-12 carbon atoms, and most preferably 8-10 carbon atoms and one or more ethoxylated C6-18 alcohols having less than 5 moles of ethoxylation.

However, Wenzel does not contain a single example of an additive composition containing both a branched C₁₂₋₂₄ alcohol AND an ethoxylated C₈₋₂₄ alcohol. In fact, the only branched alcohol specifically mentioned throughout the entire reference is "2-ethyl hexanol-1", a C₈ branched alcohol. What's more, where Wenzel does happen to actually mention a branched alcohol, it is only 2-ethyl hexanol-1 (C₈) and it is listed along with octanol, decanol and octadecanol – all LINEAR alcohols, C₈, C₁₀ and C₁₈ LINEAR alcohols to be precise.

Yet the Examiner contends that one of ordinary skill in the art would somehow be motivated to select the specific combination of a branched C₁₂₋₂₄ alcohol and an ethoxylated C₈₋₂₄ alcohol from among the many optional ingredients. To the contrary, based upon the reference's preference for shorter chain alcohols, and the disclosure of only a single short-chain branched alcohol, one of ordinary skill in the art would find no motivation to select the claimed combination. In fact, where the reference does mention a C₈ branched alcohol, the branched alcohol is seemingly equated with C₈, C₁₀ and C₁₈ LINEAR alcohols.

It is respectfully submitted that the arguments and contentions advanced by the Examiner present, at best, an instance of "obvious-to-try" rationale. However, as the Examiner is aware, obvious-to-try is not sufficient to establish *prima facie* obviousness. (See, M.P.E.P. §2145, (X)(B) 8th Edition). There is no teaching or suggestion in the cited reference which would motivate one of ordinary skill in the art to make the critical selection of the two claimed components from among the many optional ingredients which may be employed. As such, the rejection cannot stand. In *Ex parte Wittpenn*, 16 USPQ2d 1730 (BPAI 1990), the Examiner had rejected an applicant's claims on the grounds that all of the claimed components were disclosed in a prior art reference (Roggenkamp). In that case it was found that although the prior art contained all elements of applicant's invention, the prior art indicated no preference for any

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particular component of one of the elements, i.e., the nonionic surfactant. The Board there held that, "... since we have been apprised of no disclosure within the Roggenkamp reference that would have led the routineer to make the critical selections to arrive at the claimed surfactant composition, we find that no *prima facie* case of obviousness has been established and that the rejection before us cannot be sustained." (*See, id.* at 1731 (emphasis added)).

Furthermore, as the Examiner is aware, it is well-settled that in order to establish a *prima facie* case of obviousness based upon a single reference, the Examiner MUST establish that the reference contains a teaching or suggestion which would motivate one of ordinary skill in the art to modify the reference as suggested by the Examiner (it is not sufficient to say that the reference can be modified without a teaching in the cited reference to suggest the desirability of such a modification). (*See, M.P.E.P.* §2143).

The Examiner has not met the requisite burden for establishing *prima facie* obviousness. Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 14-27 based upon Wenzel.

As to the rejection of claims 28-32, Applicants respectfully submit that the secondary reference fails to remedy the deficiencies of the Wenzel reference pointed out above. The Examiner has cited the Boehmke reference to support the contention that the addition of the corrosion inhibitor is obvious. However, Boehmke fails to teach or suggest the combination of a branched C₁₂₋₂₄ alcohol and an ethoxylated C₈₋₂₄ alcohol.

Accordingly, Applicants submit that a *prima facie* case of obviousness based upon the combination of Wenzel and Boehmke has not been established. Reconsideration and withdrawal of the rejection is respectfully requested.

In view of the remarks set forth above, Applicants submit that all pending claims patentably distinguish over the prior art of record and known to Applicants, either alone or in combination. Accordingly, reconsideration, withdrawal of the rejections and a Notice of Allowance are respectfully requested.

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Respectfully submitted,

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